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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 927,463	08 13 2001	Florence Smadja-Jette	1721-33	5388

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NIXON & VANDERHYE, PC
1100 N GLEBE ROAD
8TH FLOOR
ARLINGTON, VA 22201-4714

EXAMINER

BELYAVSKY, MICHAEL A

DATE MAILED 05 11 2003

DATE MAILED 05 11 2003

2

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/927,463

Applicant(s)

SMADJA-JOFFE ET AL.

Examiner

Michail A Belyavskyi

Art Unit

1644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-27 is/are pending in the application.
- 4a) Of the above claim(s) 27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 April 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Art Unit: 1644

DETAILED ACTION

1. Claims 12 -27 are pending.

2. Applicant's election of Group I. claims 12-26 in Paper No. 20 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim 27 is withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b) as being drawn to nonelected inventions.

Claims 12-26 read on a method of producing a medicinal product to induce or stimulate differentiation of leukaemic cells are under consideration in the instant application.

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention *to which the claims are directed*.

4. Formal drawings have been submitted which fail to comply with 37 CFR 1.84. Please see the enclosed form PTO-948.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

A. Correction of Informalities -- 37 CFR 1.85

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the "Notice of Allowability."

Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136 for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

Art Unit: 1644

B. Corrections other than Informalities Noted by Draftsperson on form PTO-948.

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

Timing of Corrections

Applicant is required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR 1.185(a). Failure to take corrective action within the set (or extended) period will result in ABANDONMENT of the application.

5. Claim 12 objected to because of the following informalities: The word "stimulate" second line, and the term "CD14 CD15" are misspelled. Appropriate correction is required.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 12-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The instant claim is drawn to a method of producing a medicinal product comprising including in said medicinal product a polymer with an effective quantity of disaccharide units. However, a method steps that will results in making a polymer with an effective quantity of disaccharide units are omitted.

Art Unit: 1644

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States

9. Claims 12-16, 20-21 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Scott Ian (EP 295092).

EP 295092 teaches a method of producing a medicinal product, comprising including in said medicinal product a polymer comprising disaccharide units each composed of an N-acetyl D-glucosamine structure (see entire document, Abstract in particular). EP 295092 teaches that a polymer, comprising from 3-100 numbers of disaccharide units was obtained by a enzyme cleavage with hyaluronidase (see page 3, line 40-45, in particular). EP 295092 teaches that said polymer is present in the form of a solution or in injectable form(see page 4, lines 1-30 in particular). EP 295092 teaches a method of producing a medicinal product, comprising various unit dose of hyaluronic acid fragments (1-100 $\mu\text{g}/\mu\text{l}$) (see page 15 in particular).

It is noted that the same method was used in the instant application to produce a medicinal product as claimed (see page 22, line 9-30 in particular).

Claim 26 is included because the claimed functional limitation would be inherent properties of the referenced method of producing a medicinal product. Since the reference method of producing the medicinal product is essentially the same as claimed method ,then a medicinal product obtained by the referenced method would inherently performed the claimed process. Under the principles of inherency, if a prior art method, in its normal and usual operation, would necessarily perform the method claimed, then the method claimed will be considered to be anticipated by the prior art. When the prior art method is the same as a method described in the specification, it can be assumed the method will inherently perform the claimed process. See MPEP 2112.02.

The reference teachings anticipate the claimed invention.

Art Unit: 1644

10. Claims 12-16 and 20- 26 are rejected under 35 U.S.C. 102(a) as being anticipated by Simon, J et al (DE 19802540).

DE 19802540 teaches a method of producing a medicinal product, comprising including in said medicinal product a polymer comprising disaccharide units each composed of an N-acetyl D-glucosamine structure (see entire document, Abstract in particular). DE 19802540 teaches that a polymer, comprising from 3-100 numbers of disaccharide units or various unit dose (1-10 µg/µl) was used to induce differentiation of leukaemic cells (see abstract in particular). DE 19802540 teaches that said polymer is present in the form of a solution or in injectable form (see page particular). DE 19802540 teaches the presence of ICAM1 monoclonal antibody in medicinal product or the presence of anti-Cd44 antibody (see pages 5 and 6 in particular).

Claim 26 is included because the claimed functional limitation would be inherent properties of the referenced method of producing a medicinal product. Since the reference method of producing the medicinal product is essentially the same as claimed method ,then a medicinal product obtained by the referenced method would inherently performed the claimed process. Under the principles of inherency, if a prior art method, in its normal and usual operation, would necessarily perform the method claimed, then the method claimed will be considered to be anticipated by the prior art. When the prior art method is the same as a method described in the specification, it can be assumed the method will inherently perform the claimed process. See MPEP 2112.02.

The reference teachings anticipate the claimed invention.

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Art Unit: 1644

12. Claims 17-19 are rejected under 35 U.S.C. 103(a) as being obvious over Scott Ian (EP 295092) or Simon, J et al (DE 19802540) .

The teaching of EP 295092 or DE 19802540 have been discussed, supra.

EP 295092 or DE 19802540 does not teach a method of producing a medicinal product wherein polymer unit dose is between approximately 1 and 10 mg/kg as claimed in claim 17; or between 2 and 5 mg/kg as claimed in claim 18 or approximately 3 mg/kg as claimed in claim 19.

The claimed dosage between approximately 1 and 10 mg/kg as claimed in claim 17; or between 2 and 5 mg/kg as claimed in claim 18 or approximately 3 mg/kg as claimed in claim 19 overlaps the reference dosage in a medicine product wherein said medicine product comprises composition including various unit dose of fragments of hyaluronic acid (1-10 $\mu\text{g}/\mu\text{l}$ as taught by DE 19802540) or (1-100 $\mu\text{g}/\mu\text{l}$ as taught by EP 295092) and is therefore an obvious variation of the reference teaching absent a showing of unobvious property. Further, it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 220 F2d 454,456,105 USPQ 233; 235 (CCPA 1955). see MPEP § 2144.05 part II A.

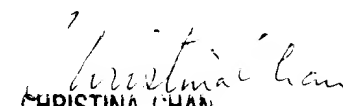
13. No claim is allowed.

14. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which Applicant may become aware in the specification.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michail Belyavskiy whose telephone number is (703) 308-4232. The examiner can normally be reached Monday through Friday from 9:00 AM to 5:30 PM. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 305-3014.

Michail Belyavskiy, Ph.D.
Patent Examiner
Technology Center 1600
March 10, 2003


CHRISTINA CHAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600